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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,307	10/30/2003	Hisao Kamo	OMY-0032	6574
23353	7590	10/14/2004	EXAMINER	
RADER FISHMAN & GRAUER PLLC			LE, HOA VAN	
LION BUILDING			ART UNIT	
1233 20TH STREET N.W., SUITE 501			PAPER NUMBER	
WASHINGTON, DC 20036			1752	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,307

Applicant(s)

KAMO, HISAO

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

This is in response to Paper filed on 10 September 2004.

- I. Applicant elects the invention of Group I, material claims 1-5 without traverse being acknowledged.
- II. Applicant urges that claims 6-7 is "not just a use". It is submitted that ---a step of using--- has and is given no value in a material claims. No consideration or search is made. it would have and be given full value in a proper method or process of using claim only. Applicant fails to make a proper correction as clearly pointed out and set forth on the record.
- III. Applicants prior art submissions have been considered to the extend of the English language as provided.
- IV. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. Please also see the related issue with respect no patentable sense as

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stated in *In re Hutchison*, 69 USPQ 138. The language "color developing agent", "pH...", "alkali agent", "compound having pKa..." or the like is considered as property of a material and searched as it appeared.

B. *In re Schreiber*, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in *Swinehart*... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." A statement or argument alone may have and be given a little to no value because it is not factual evidence.

V. An initial search has found about a dozen of additional references on top of some particularly pertinent references as submitted by applicant. A set of at two references will be applied at one time when all applied set of references are overcome.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manabu et al (English language translation of JP 09-090581 as provided).

Manabu et al disclose, teach, suggest, demonstrate and reduce to practice with more than one solution for a full and complete color development with (a) one solution comprising a color developing agent and having a pH solution of up to 13 and (b) another solution having a pH of up to 8 and comprising an alkali agent and an acidic group containing compounds. Please see the whole disclosure of the applied reference, especially at the abstract, compounds c(1-35), compounds D(14-15, 33-34 and 35), paragraphs 0086-0087, 0098-0104, compound K-I(1-5), K-II(1-9), K-III(1-10), K-IV(1-3), K-V-(1-3), paragraphs 0110, 0151-0152 with Table with Experiments Nos. "1-12" and "1-13". The law requires that applicant must provide convincing evidence that none of the applied compounds or solutions does not have or is close to have the claimed property. An argument alone is not a factual evidence may have and be given a little to no value. It is reasonable to one skilled in the art at the time the invention was made that Manabu et al disclose, teach, suggest, demonstrate and reduce to practice with the embodiments of the claims. One applicants is urged to show or provide convincing evidence to the contrary for the patentability of the claims to avoid any work that may be later required because a claim would have no value if one later show or provide a claimed property from pieces of a prior art. No evidence under Rule 132 will be entered or considered after a mailing of a final Office action. The next Office action may a final one. It is now notified for the record.

VII. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buongiorno et al (6,136,518 as provided).

Buongiorno et al disclose, teach, suggest, demonstrate and reduce to practice with more than one solution for a full and complete color development with (a) one solution comprising a color developing agent and having a pH solution of up to 12.5 and (b) another solution having a pH of up to 12.5 and comprising an alkali agent and an acidic group containing compounds.

Please see the whole disclosure of the applied reference, especially at the abstract, compounds c(1-35), compounds D(14-15, 33-34 and 35), paragraphs 0086-0087, 0098-0104, col.2:32-3:10, 4:32-36 and 42 to 5:413-14 and 15-16, 6:10-13 and 15-23, 8:55 to 10:33 Table 1, col.11:32-67, Examples 1 and 2. The law requires that applicant must provide convincing evidence that none of the applied compounds or solutions does not have or is close to have the claimed property. An argument alone is not a factual evidence may have and be given a little to no value. It is reasonable to one skilled in the art at the time the invention was made that Manabu et al disclose, teach, suggest, demonstrate and reduce to practice with the embodiments of the claims. One applicants is urged to show or provide convincing evidence to the contrary for the patentability of the claims to avoid any work that may be later required because a claim would have no value if one later show or provide a claimed property from pieces of a prior art. No evidence under Rule 132 will be entered or considered after a mailing of a final Office action. The next Office action may a final one. It is now notified for the record.

VIII. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa et al (5,972,573).

Miyazawa et al disclose, teach, suggest, demonstrate and reduce to practice with more than one solution for a full and complete color development with (a) one solution comprising a

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color developing agent and having a pH solution of almost up to 10 and (b) another solution having a pH of up to 8 and comprising an alkali agent and an acidic group containing compounds. Please see the whole disclosure of the applied reference, especially at the abstract, col.7:57 to 8-58, 9:1-10, 15-26, 10:6-18, 12:1-4, 14:27-39, compounds II-6, III(1-6), IV(1-11) and V(1-8), VII(1-3), IX(1-17, X(1-2) XI(1-11), Examples with solutions “(CD-1)”, “(OX-1)”, “(CD-2)”, “(OX-2)”, TABLE 2 with Process Nos. 205-220, “(CD-3)”, “(OX-3)”, “(CD-4)”, “(OX-4)”, TABLE 4 with Process Nos. 413-416, (CD-6)”, “(OX-6)”, TABLE 5 with Process Nos. 601-624, TABLE 6 with Process Nos. 701-715, TABLE 7 with Process Nos. 801-815. The law requires that applicant must provide convincing evidence that none of the applied compounds or solutions does not have or is close to have the claimed property. An argument alone is not a factual evidence may have and be given a little to no value. It is reasonable to one skilled in the art at the time the invention was made that Manabu et al disclose, teach, suggest, demonstrate and reduce to practice with the embodiments of the claims. One applicants is urged to show or provide convincing evidence to the contrary for the patentability of the claims to avoid any work that may be later required because a claim would have no value if one later show or provide a claimed property from pieces of a prior art. No evidence under Rule 132 will be entered or considered after a mailing of a final Office action. The next Office action may a final one. It is now notified for the record.

IX. Nakahanada et al (5,698,382) is cite to show the known use of compounds being read with the embodiments of claims 4 as provided.

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X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
08 October 2004

HOA VAN LE
PRIMARY EXAMINER

